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EXAMINER	
ALAM, SHAHID AL	
ART UNIT	**PAPER NUMBER**
2162	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/087,003	MARCUS, DWIGHT	
	Examiner	Art Unit	
	Shahid Al Alam	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-71 and 79-83* is/are pending in the application.

4a) Of the above claim(s) *23-29 and 57-59* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22,30-56,60-71 and 79-83* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-71 and 79-83* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *02282008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Reissue Applications

1. Claims 1 – 71 and 79 – 83 are pending in this Office action.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1 – 22, 30 – 56, 60 – 71, 79 and 80 – 83, drawn to maintaining a database containing selected information about each of a plurality of media elements and automatically selecting a temporal organization for said selected media elements, classified in class 707, subclass 104.1.

II. Claims 23 – 29 and 57 – 59, drawn to comparing received information to sequence of cues, classified in class 707, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

Inventions as listed in Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination has separate utility such as follow.

Group I teaches maintaining a database containing selected information about each of a plurality of media elements and automatically selecting a temporal organization for said selected media elements while Group II teaches comparing received media program information to sequence of cues.

See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Gilbert G. Kovelman, Reg. No. 19,552 on December 15, 2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1 – 22, 30 – 56, 60 – 71, 79 and 80 – 83. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23 – 29 and 57 – 59 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 30 – 41 and 60 – 65 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application with useful, concrete and tangible result.

The claimed invention is addressed to a method and system of creating media programming from a plurality of stored media elements, comprising: selecting from a database containing information concerning said media elements and selecting transitions for each of said media elements.

The invention as recited in the claim for **selecting from a database** containing information concerning said media elements and **selecting transitions** for each of said media elements. It is unclear as to what kind of tangible output is obtained by **selecting transitions** for each of said media elements.

5. Claims 11 – 22, 36 – 41 50 – 56 and 63 – 65 are rejected under 35 USC 101 for being "software per se".

The claimed invention is addressed to "a system" that can be interpreted as referring to lines of programming within a computer system, rather than referring to the system as a physical object. The claimed invention is also addressed to "a database", "selection means", "assembling means", that are not a hardware system but are software systems (software). Accordingly, the claim becomes nothing more than sets of software instructions which are "software per se".

"Software per se" is non-statutory under 35 USC 101 because it is merely a set instruction without any defined tangible output or tangible result being produced. The requirement for tangible result under 35 USC 101 is defined in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47USPQ2d 1596 (Fed. Cir. 1998).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1 – 22, 30 – 35, 36 – 41, 47, 50 – 51, 66, 67, 79 and 80 – 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,864,868 issued to David Contois (hereinafter "Contois") and in view of Chung-Sheng Li et al., "Multimedia Content Description in the Infopyramid" (hereinafter "Li").

With respect to claim 1, Contois teaches a method of creating media programming (abstract, column 11, lines 32 – 33 and column 12, lines 1 – 12), comprising:

maintaining a database containing selected information about each of a plurality of media elements (column 4, lines 39 – 49);

selecting a plurality of said media elements in response to a request for media programming (column 4, lines 46 – 49), and

selecting a temporal organization for said selected media elements (column 13, lines 61 – 63), said temporal organization not being dictated by said selected information (column 4, lines 53 – 55 and 59 – 67).

Contois teaches listings of media elements into media programming (column 11, lines 45 – 56). Contois does not explicitly teach **assembling** said media elements into media programming as claimed.

Li teaches claimed **assembling** said media elements into media programming. Li teaches Infopyramid and the Infopyramid is a framework for aggregating the individual components of multimedia content (Page 3789, Right column, lines 19 – 25).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify the teachings of Contois with the teachings of Li to enhance a system to better maintaining, translating, transcoding and generating the content of the multimedia database. It would have been obvious to use Infopyramid so as to provide a hierarchy for content descriptors in order to guide search and retrieval (Li: Page 3789, right column, lines 19 – 27).

As to claim 2, said media elements are audiovisual clips, and said media programming is an audiovisual program (Li: page 3789, right column, lines 28 – 30).

As to claim 3, said media elements are still photographs, and said media programming comprises a series of said still photographs (Contois: column 12, lines 15 – 21).

As to claim 4, said selected information comprises content information relating to said media assets (Li: page 3789, right column, lines 28 – 30).

As to claim 5, said selected information comprises a plurality of tags associated with each of said media elements, at least one of said tags being a content tag containing information relating to content of said media element, and at least one of said tags being a control tag containing information other than content information (Li: page 3789, left column, line 44 – right column, line 4).

As to claim 6, media element is a media clip, and at least one of said control tags contains transition information (Li: page 3789, left column, line 46 – right column, line 4 and lines 28 – 30).

As to claim 7, at least one of said control tags contain a luminance range for a portion of said media clip (Li: page 3790, left column, lines 45 – 52).

As to claim 8, said step of selecting further comprises selecting two elements based on said request, selecting a temporal order for said two elements, and determining based on information in said control tags whether said two elements may be assembled in the selected temporal order, and, if not, deselecting at least one of said two elements (Contois: column 11, lines 54 – 67 and column 12, lines 1 – 36).

As to claim 9, said step of selecting further comprises selecting two elements based on said request, selecting a temporal order for said two elements, and selecting transitions for said two elements based on transition information associated with each of said elements and transition rules (Contois: column 11, lines 54 – 67 and column 12, lines 1 – 36).

As to claim 10, the step of obtaining demographic information concerning an intended view of a programming prior to said step of selecting, and employing said demographic information in said step of selecting (page 3789, right column, lines 39 – 46 and page 3790, left column, lines 1 – 7).

As to claim 47, the step of obtaining desired content information concerning an intended view of a the programming prior to said step of selecting, and employing said desired content information in said step of selecting (Contois: column 4, lines 39 – 67).

As to claim 66, assembling an automatically assembled media clip into said media programming (Page 3789, Right column, lines 19 – 25).

As to claim 67, obtaining psychographics information concerning an intended view of the programming prior to said step of selecting, and employing said psychographics information in said step of selecting (Contois: column 4, lines 39 – 67).

8. Claims 42 – 46, 48, 49, 52 – 56, 60 – 65 and 68 – 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Contois in view of Li and further in view of U.S. Patent Number 5,966,121 issued to John Hubbell et al. ("Hubbell").

With respect to claims 42 – 46, 48, 49 and 68 – 71, Contois in view of Li disclosed all the limitations except that they do not explicitly teach transition information, style information, filtering and tagging as taxonomic, attribute and reusability as claimed.

With respect to claims 42 – 46, 48, 49 and 68 – 71, Hubbell discloses claimed transition information transition information, style information, filtering and tagging as taxonomic, attribute and reusability.

As to claims 42 and 43, said transition information comprises: a transition point and a transition type (Hubbell: column 9, lines 53 – 56).

As to claims 44 – 46, said transition type is a dissolve, a cut and a fade (Hubbell: column 7, lines 26 – 30 and column 14, line 65 – column 15, line 6).

As to claim 48, a modification parameter wherein said modification parameter is used to modify a transition (Hubbell: column 5, lines 17 – 25).

As to claim 49, the step of obtaining desired style information concerning an intended view of a the programming prior to said step of selecting, and employing said desired style information in said step of selecting (Hubbell: column 4, line 66 – column 5, line 8).

As to claim 68, filtering a first media element out of consideration for inclusion in said media programming wherein said filtering is performed by a moderation layer (Hubbell: column 5, lines 17 – 25).

As to claim 69 – 71, at least one of said tags is a taxonomic tag, an attribute tag and a reusability tag (Hubbell: column 10, lines 20 – 28 and column 14, lines 10 – 16).

Hubbell, further teaches, media element is a media clip, and at least one of said control tags contains transition information (Hubbell: column 10, lines 20 – 28) and at least one of said control tags contain a luminance range for a portion of said media clip (Hubbell: column 5, lines 9 – 25 and column 10, lines 20 – 28).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine Hubbell with Contois and Li because combination would permit access to video editing format and to efficient modification of the data signal portion of a multimedia bit-stream (Hubbell: column 2, lines 54 – 61).

The subject matter of claims 11 – 22 and 50 – 56 are rejected in the analysis above in claims 1 – 10, 42 – 49 and 66 – 71 and these claim are rejected on that basis.

The subject matter of claims 30 – 35 and 60 – 62 are rejected in the analysis above in claims 1 – 10, 42 – 49 and 66 – 71 and these claim are rejected on that basis.

The subject matter of claims 36 – 41 and 63 – 65 are rejected in the analysis above in claims 1 – 10, 42 – 49 and 66 – 71 and these claim are rejected on that basis.

The subject matter of claims 79 and 80 – 83 are rejected in the analysis above in claims 1 – 10, 42 – 49 and 66 – 71 and these claim are rejected on that basis.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (571) 272-4030. The examiner can normally be reached on Monday-Thursday 8:00 A.M. - 4:00 P.M. .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shahid Al Alam
Primary Examiner
Art Unit 2162

January 31, 2008